

### **REMARKS**

In the Office Action of January 26, 2009, claims 1-14 stand rejected in view of prior art. No other objections or rejections were made in the Office Action.

#### ***Status of Claims and Amendments***

In response to the Office Action, Applicants have amended claims 1 and 7 as indicated above. In addition, withdrawn claims 15-49 have been cancelled in view of the election of species. Applicants wish to thank the Examiner for the thorough examination of this application. In summary, claims 1-14 are pending, with claim 1 being the only independent claim. Reexamination and reconsideration of the pending claims are respectfully requested in view of the following comments.

#### ***Election of Species***

On page 2 of the Office Action, Applicants' election without traverse in the reply of October 12, 2008 was acknowledged. Thus, non-elected claims 15-49 were withdrawn from further consideration. Applicants have cancelled withdrawn claims 15-49.

#### ***Rejections - 35 U.S.C. § 102***

On page 2 of the Office Action, claims 1-9 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,622,685 (Takahashi et al.). In response, Applicants have amended independent claim 1 to further distinguish the prior art.

In particular, independent claim 1 clearly requires the cutting head of the cutting tool to have a first cutting edge *and* a *second* cutting edge. Post-amendment, claim 1 also requires that this second cutting edge form *uniform* roughened fracture surfaces on the surface of the article. Clearly, this structure is *not* disclosed or suggested by Takahashi et al. or any other prior art of record. On page 2 of the Office Action, it is written that Takahashi et al. discloses "a first cutting edge 7a and a second cutting edge 20b." Applicants respectfully

assert that 20b, an edge of the cut chip 20, could not *reasonably* be interpreted as a cutting edge of the cutting tool 7, particularly in view of the fact that the cut chip 20 and the cutting tool 7 are separate elements. Nevertheless, assuming for the sake of argument that one were to consider the edge 20b of the cut chip 20 to be a cutting edge of the cutting tool 7, Takahashi et al. would still fail to meet the requirements of amended claim 1 because the edge 20b of the cut chip 20 does not form uniform roughened fracture surfaces on the article's surface. As seen in Figures 9 and 10 of Takahashi et al., the roughed surfaces 9 are *not uniform* because they are partially (9b) formed by the uncontrolled application of the main part 20a of the chip 20 as the chip is being cut out of the surface.

It is well settled under U.S. patent law that for a reference to anticipate a claim, the reference must disclose *each and every element* of the claim within the reference. Therefore, Applicants respectfully submit that claim 1, as now amended, is not anticipated by the prior art of record. Withdrawal of this rejection is respectfully requested.

Moreover, Applicants believe that dependent claims 2-9 are also allowable over the prior art of record in that they depend from independent claim 1, and therefore are allowable for the reasons stated above. Also, these dependent claims are further allowable because they include additional limitations. Thus, Applicants believe that since the prior art of record does not anticipate independent claim 1, neither does the prior art anticipate the dependent claims.

Applicants respectfully request withdrawal of the rejections.

#### ***Rejections - 35 U.S.C. § 103***

On page 3 of the Office Action, claims 10-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Takahashi et al. in view of U.S. Patent Application Publication No. 2001/0023859 (Beck et al.). In response, Applicants have amended independent claim 1 as discussed above. Applicants believe Takahashi et al. fails to anticipate independent claim

1 as amended. Therefore, Applicants believe that dependent claims 10-14 are also allowable over the prior art of record in that they depend from independent claim 1, and therefore are allowable for the reasons stated above. Also, these dependent claims are further allowable because they include additional limitations. Thus, Applicants believe that since the prior art of record does not disclose or suggest the invention as set forth in independent claim 1, the prior art of record also fails to disclose or suggest the inventions as set forth in the dependent claims.

Therefore, Applicants respectfully request that this rejection be withdrawn in view of the above comments.

***Prior Art Citation***

In the Office Action, additional prior art references were made of record. Applicants believe that these references do not render the claimed invention obvious.

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In view of the foregoing amendment and comments, Applicants respectfully assert that claims 1-14 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested.

Respectfully submitted,

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